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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/283,192	04/01/1999	YUTAKA KURABAYASHI	35.C1331	9638

5514 7590 08/26/2002

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

22

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/283,192

Applicant(s)

KURABAYASHI, YUTAKA

Examiner

Callie E. Shosho

Art Unit

1714

**—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —**

THE REPLY FILED 09 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 61-82.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 20.
10. ☐ Other: \_\_\_\_\_

**Attachment to Advisory Action**

1. Applicants' amendment filed 8/9/02 has been fully considered. However, the amendment has not been entered given that it raises new issues that would require further consideration. It is the examiner's position that the changes to present claim 82 would raise new issues under 35 USC 112, first and second paragraphs.

Specifically, with respect to the new issues under 35 USC 112, first paragraph, it is noted that claim 82 has been amended to recite that the encapsulated coloring material is a "non-self-dispersing pigment". It is the examiner's position that the cited phraseology clearly signifies a "negative" or exclusionary limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph. Ex Parte Grasselli, Suresh, and Miller, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F.2d 453. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

Further, claim 82 has been amended to recite that the self-dispersing pigment and the resin encapsulating a coloring material are present at a "solid concentration A". It is the examiner's position that the specification, while being enabling for solid concentration of 8% (as found in the examples), does not reasonably provide enablement for any solid concentration of self-dispersing pigment and the resin encapsulating a coloring material. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. That is, while the examples disclose the use of self-dispersing pigment and resin encapsulating a coloring

material or self-dispersing pigment only in solids concentration of 8%, there does not appear to be any disclosure in the specification for self-dispersing pigment and resin encapsulating a coloring material at any solids concentration.

Case law holds that applicant's specification must be "commensurately enabling [regarding the scope of the claims]" *Ex Parte Kung*, 17 USPQ2d 1545, 1547 (Bd. Pat. App. Inter. 1990). Otherwise undue experimentation would be involved in determining how to practice and use applicant's invention. The test for undue experimentation as to whether or not all compounds within the scope of claims 63-70 and 73-82 can be used as claimed and whether claims 63-70 and 73-82 meet the test is stated in *Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. App. Inter. 1986) and *In re Wands*, 8 USPQ2d 1400, 1404 (Fed.Cir. 1988). Upon applying this test to the present claims, it is believed that undue experimentation would be required because (a) the quantity of experimentation necessary is great since claims 63-70 and 73-82 read on any solids concentration, (b) there is no direction or guidance presented for making an ink comprising self-dispersing pigment and resin encapsulating a coloring material or self-dispersing pigment only in any solids concentration, and (c) there is an absence of working examples concerning making an ink comprising self-dispersing pigment and resin encapsulating a coloring material or self-dispersing pigment only in any solids concentration. In light of the above factors, it is seen that undue experimentation would be necessary to make and use the invention of claims 63-70 and 73-82.

With respect to the new issues under 35 USC 112, second paragraph, it is the examiner's position that the phrase "solid concentration A" in claim 82 leads to confusion in the scope of the

Art Unit: 1714

claims because it is not clear what is meant by this phrase. What solid concentrations does this encompass? Does "A" represent a specific value of solids concentration or can "A" be any value?

Further, claim 82 recites, "resin being contained in a sufficient amount to provide rub resistance to an image produced with the ink". The scope of the claim is confusing because it would appear from the examples in the present specification that it is the resin encapsulating a coloring material, not the resin itself, which provides rub resistance.

**NOTE:** If applicant responds to the above with the submission of an amendment/response that addresses the above issues, although such submission would reach this case after a final rejection, nevertheless, the examiner will consider the amendment/response.

  
Callie Shosho

8/22/02

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